

REMARKS

Claims 1 and 4-9 are pending in the present application. No claims are being amended, added or canceled. Thus, a listing of the claims is not needed.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw the only rejection and allow the currently pending claims.

Issues under 35 U.S.C. § 112, First Paragraph

Claims 1 and 4-9 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner states that the present specification does not appear to support pending claim 1 which recites “nonionic cycloaliphatic diisocyanate in the backbone structure of the polyurethane molecule”. Applicants respectfully traverse, and reconsideration and withdrawal of this rejection are respectfully requested.

Applicants respectfully submit that paragraph [0018] of the originally filed specification supports the disputed claim language. For the Examiner’s convenience, Applicants have reproduced paragraph [0018] below:

[0018] The cover is then covered on the core. In the golf ball of the present invention, it is required for the cover to comprise polyurethane-based thermoplastic elastomer formed by using cycloaliphatic diisocyanate as a base resin in view of yellowing resistance, scuff resistance and the like, preferably polyurethane-based thermoplastic elastomer formed by using diisocyanate having no double bond in backbone structure in molecule in view of weathering

resistance. Polyurethane-based thermoplastic elastomer generally contains polyurethane structure as hard segment and polyester or polyether as soft segment. The polyurethane structure generally contains diisocyanate and curing agent, such as amine-based curing agent. In the golf ball of the present invention, the cover comprises as a base resin polyurethane-based thermoplastic elastomer that the diisocyanate is cycloaliphatic diisocyanate.

The second sentence of paragraph [0018] states that the polyurethane-based thermoplastic elastomer is formed by using cycloaliphatic diisocyanate in consideration of yellowing resistance, scuff resistance and the like. The third sentence of paragraph [0018] refers to the polyurethane-based thermoplastic elastomer having a polyurethane structure as the hard segment and polyester or polyether as the soft segment in the cover of the golf ball. The polyurethane structure, as stated in the fourth sentence of the paragraph [0018], contains diisocyanate and a curing agent, such as an amine-based curing agent. The polyurethane-based thermoplastic elastomer has the following structure:

--(polyurethane segment)--(soft segment)--(polyurethane segment)--(soft segment)--(polyurethane segment)--

The polyurethane segment (see schematic above) contains cycloaliphatic diisocyanate which does not contain double bonds, because the double bonds generally cause yellowing and the like. Accordingly, the polyurethane-based thermoplastic elastomer is formed by using the diisocyanate that has no double bonds. The double bonds are also not in the backbone structure in (the elastomer) molecule in consideration of weathering. Of course, this is mentioned in

paragraph [0018] after the word “preferably” (see second sentence). Applicants also note that the term “backbone” is used for polymers in the field of polymer chemistry, and therefore the phrase “in [the] backbone in [a] molecule” is an explanation that refers to the thermoplastic elastomer (which is polyurethane-based).

Thus, Applicants respectfully submit that claim 1 is supported by the present specification. Applicants further note that the primary consideration here is factual and depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure. *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). Here, one of skill in the art, upon reading the present specification and with knowledge in the art, would understand that the present inventors had possession of the claimed invention (at the time of filing the present application).

Reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

In view of the above remarks, it is believed that no other issues remain. Thus, this application should now be placed in condition for allowance.

If any questions arise in the above matters, please contact Applicant’s representative, Andrew D. Meikle (Reg. No. 32,868), in the Washington Metropolitan Area at the phone number listed below.


Application No. 09/987,469
Reply to Non-Final Action dated August 6, 2008
Art Unit 3711

Docket No.: 0020-4925P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: August 6, 2008

Respectfully submitted,

By  #48,501
Andrew D. Meikle
Registration No.: 32,868
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant